

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:) Confirmation No.: 8706
George K. Phillips, et al.) Group Art Unit: 1774
Serial No.: 10/686,758) Examiner: Ferguson, Lawrence D.
Filed: October 15, 2003)
For: COPY-RESISTANT SECURITY)
PAPER)

REPLY BRIEF-37 CFR §41.41

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Brief is in reply to the Examiner's Answer, dated June 9, 2008. Appellant agrees with the statements made in item numbers (1)-(8) and (11) of the Examiner's Answer, and responds to the statements made in item numbers (9) and (10) of the Examiner's Answer as follows:

VII. Arguments

A. Rejection under 35 U.S.C. 102(b) over Phillips

1. Claims 1, 3, 4, 15-17, 20, 22, 23, and 33-35, 38, 41, 44, and 47

The claimed invention requires bearer information to be overprinted on both a reflective layer and a diffusive layer. With respect to Phillips, the Examiner has equated the latent message 14 as the claimed "bearer information," the reflective layer 10 of Phillips as the claimed "reflective layer," and the raised markings 16 as the claimed

“diffusive layer.” Assuming, arguendo, that these characterizations can be made, the Examiner has not set forth an embodiment disclosed in Phillips that overprints the “latent message 14” over the “reflective layer 10” and the “raised markings 16.”

Instead, the Examiner has completely tortured the teachings of Phillips to somehow arrive at a hypothetical embodiment that requires the “latent message” to not only be overprinted on the “reflective layer 10,” but also to be overprinted on the “raised markings 18.” Not only is this hypothetical embodiment not disclosed in Phillips, it is not enabled by it.

In particular, the Examiner first concludes that the latent message 14 (which is indisputably disclosed throughout Phillips as being optically formed by the contrast between the reflective layer 10 and the raised markings 16) is the claimed bearer information (see page 6, lines 9-15 of Examiner’s Answer). Keying off of the statement made in col. 3, lines 61-62 of Phillips that “the image relief pattern 14 [is] imprinted on the security overlay marker 10,” the Examiner concluded that the latent message 14 is not actually optically formed by the contrast between the reflective layer 10 and raised markings 16, but rather is printed over the reflective layer 10 and raised markings 16 (see page 7, lines 10-12, 17-20 of Examiner’s Answer).

However, col. 3, lines 61-62 of Phillips speaks of overprinting an “image relief pattern 14.” Thus, following the Examiner’s logic, a latent message 14 can be formed by imprinting an “image relief pattern” over another relief pattern (i.e., the raised markings 16) and the reflective layer 10. This does not make sense, and to the extent that Phillips discloses that a latent message can be formed by overprinting a relief

pattern over another relief pattern (which it does not), Phillips does not teach how this can be done, and thus, there is no enabling disclosure.

As previously discussed in Appellant's Appeal Brief, the statement "image relief pattern 14 imprinted on the security overlay marker 10" obviously means that the latent message 14 is formed by imprinting a relief pattern (i.e., the raised markings 16) over the reflective layer 10. If Phillips would have intended that the "image relief pattern 14" be printed over the raised markings 16, it would have said so. However, it only refers to the reflective layer 10 as being overprinted on.

Assuming arguendo that the Examiner is allowed to completely ignore the language "relief pattern" in the statement "image relief pattern 14 imprinted on the security overlay marker 10," and to completely ignore the fact that this statement refers to only the overlay marker 10 (i.e., the reflective layer as characterized by the Examiner) as the element to be printed on, Phillips does not teach how a "latent image 14" could be overprinted on the reflective layer 10 and raised markings 16, and thus, does not enable the hypothetical embodiment surmised by the Examiner.

The claimed invention also requires the bearer information to be rendered unreadable on a copy of the document. Despite the fact that nowhere does Phillips disclose that the "latent message 14" would be unreadable on a document copy, the Examiner states that such a result is inherent, because "copiers conventionally do not reproduce hidden messages, especially a message that is only readable at certain angles, as copiers reproduce visually readable text or printing" (see page 8, lines 4-7 of Examiner's Answer). However, there is no basis for this conclusion. Conventional copiers often reproduce messages that cannot be viewed by a person. In fact,

reproducing viewable messages on a copy that cannot be viewed by a person on the original is the basis for latent copy-void message technology, as evidenced by col. 4, lines 1-6 of U.S. Patent No. 5,704,651.

The Examiner responded by concluding that the fact that Phillips '651 teaches reflective images that are reproduced by a copier "does not necessarily mean the overprint of Phillips '248 would necessarily be copied as a black image." However, Appellant does not need to make a *prima facie* case that the claimed invention is not anticipated. It is the Examiner that must make a *prima facie* case that the claimed invention is anticipated, and concluding that the latent message 14 in Phillips '248 would inherently not be readable on a copy based merely on conjecture is not sufficient to do so (especially in view of U.S. Patent No. 5,704,651). Although Appellant is not required to present evidence to show that the claimed invention is not anticipated, since the Examiner has not made a *prima facie* case of anticipation in the first place, Appellant has done by setting forth a patent that clearly shows that a message that cannot be visualized on an original can, indeed, be reproduced on a copy. The Examiner has provided no evidence or reasoning to show otherwise.

The Examiner further stated that "even if the overprint of Phillips '248 would be copied as a black image, Phillips '651 teaches that the overprint image on a copy would be virtually unreadable at any angle as opposed to the way it appears on the original. Phillips '651 does not teach the copied overprint being clearly readable under any circumstance." (see page 9, lines 1-5 of Examiner's Answer). However, Phillips '651 does not disclose this, and the Examiner has not cited anything in Phillips '651 to support this conclusion. Notwithstanding this, the Examiner's conclusion is completely

irrelevant, since, if the latent message 14 of Phillips '248 turns black on a copy, and is thus, viewable on the copy at even one angle, the latent message 14 is obviously not rendered readable, as required by the claimed invention.

2. Claims 9, 10, 18, 19, 28, 36, and 37

In response to Appellant's argument that the relief markings 16 of Phillips are not disclosed as being non-black or white, the Examiner concluded that "if Phillips wanted to display the diffusive layer in any color other than white, it would be blackened, as shown for the overprint (14) which is darkened to show that it is non-white" (see page 9, lines 11-14 of Examiner's Answer). However, the overprint (14) is shown to be black in Phillips merely to illustrate that the latent message 14 can be seen at the viewing angle shown in Fig. 3. By making this conclusion, the Examiner has essentially concluded that every white that is shown in black and white drawings in every patent means that the inventors intended the respective features to be white. This obviously is not the case.

3. Claims 11 and 29

In response to Appellant's argument that the raised markings 16 of Phillips are not disclosed as being nano-characters, the Examiner concluded that "Figure 5 shows each raised marking (16) as combining to form a plurality of nano-characters (rectilinear structures)." However, not only does Phillips not disclose that each raised marking 16 is a nano-character, it does not disclose that each raised marking 16 forms a character at all.

4. Claims 39, 42, 45, and 48

In response to Appellant's argument that the latent message 14 (as the so-called bearer information) of Phillips is not disclosed as being readable on the document original at any viewing angle, the Examiner concluded that "Phillips appears to be capable of allowing the bearer information to be readable on an original document, based upon its interaction with the reflective and diffusive layers taught by Phillips." This may be true, but these claims require that the bearer information be readable on the document original at any viewing angle. The latent message 14 (which the Examiner characterized as being the bearer information) clearly is not disclosed in Phillips as being viewable at any angle, since Phillips is directed to creating a latent message that is only viewable at a limited range of angles (see Abstract of Phillips).

5. Claims 40, 43, 46, and 49

In response to Appellant's argument that the latent message 14 (as the so-called bearer information) of Phillips is not disclosed as being composed of toner or ink, the Examiner stated that "because the imprinted image relief pattern (14) is imprinted on the overlay marker, which comprise the reflective and diffusing layers and the overlay marker comprises ink or toner receptive material, it is reasonable to conclude that the imprinted image relief pattern (14) is imprinted with the ink or toner as disclosed in column 6, lines 50-52 of Phillips." (see paragraph bridging pages 11-12 of Examiner's Answer).

However, for the purposes of showing that Phillips discloses the subject matter of the independent claims, the Examiner characterized the "latent message 14" as the bearer information, so it is the "latent message 14" that must comprise ink or toner

receptive material for the purposes of determining whether Phillips discloses the subject matter of these dependent claims. The fact that the overlay marker is disclosed in Phillips as being composed of ink or toner receptive material is irrelevant to the determination of whether the latent message 14 is composed of an ink or toner material. Phillips does not expressly disclose why the overlay marker can be composed of an ink or toner receptive material, but presumably, it is so that actual bearer information (unrelated to the latent message 14) can be overprinted anywhere on the document.

Respectfully submitted,

VISTA IP LAW GROUP LLP

Dated: August 6, 2008

By:


Michael J. Bolan
Reg. No. 42,339

Customer No. 23410
VISTA IP LAW GROUP LLP
2040 Main Street, 9th Floor
Irvine, CA 92614
Tel. (949) 724-1849
Fax (949) 625-8955